

ESTTA Tracking number: **ESTTA512538**

Filing date: **12/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Spy Optic Inc.
Granted to Date of previous extension	01/02/2013
Address	2070 Las Palmas Drive Carlsbad, CA 92011 UNITED STATES
Correspondence information	William J. Brucker Stetina Brunda Garred & Brucker 75 Enterprise, Suite 250 Aliso Viejo, CA 92656 UNITED STATES opposition@stetinalaw.com

Applicant Information

Application No	85580079	Publication date	09/04/2012
Opposition Filing Date	12/21/2012	Opposition Period Ends	01/02/2013
Applicant	BASE SPY CRAFT, LLC 1800 POST OAK BLVD 6 BLVD PLACE STE. 450 Houston, TX 77056 UNITED STATES		

Goods/Services Affected by Opposition

Class 018. All goods and services in the class are opposed, namely: tote bags, backpacks, luggage, sports bags, travel bags, wallets
Class 025. All goods and services in the class are opposed, namely: clothing, namely, t-shirts, sweatshirts, jackets, hats, caps
Class 028. All goods and services in the class are opposed, namely: stuffed toy animals; intrigue and espionage-themed toys, namely, bath toys, electric action toys, mechanical toys, plush toys, talking toys, toy weapons, toy spy glasses, toy cameras, toy binoculars, and toy disguises
Class 035. All goods and services in the class are opposed, namely: retail store services featuring intrigue and espionage themed merchandise, namely, clothing, decorative items, and souvenirs; online retail gift shops featuring intrigue and espionage-themed items


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1981513	Application Date	04/07/1994
Registration Date	06/18/1996	Foreign Priority Date	NONE
Word Mark	SPY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/09/00 First Use In Commerce: 1995/01/00 glasses and sunglasses		

U.S. Registration No.	1989431	Application Date	04/07/1994
Registration Date	07/30/1996	Foreign Priority Date	NONE
Word Mark	EYESPY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/01/00 First Use In Commerce: 1985/01/00 eyeglasses, sunglasses, eyeglass cords and eyeglass cases		


U.S. Registration No.	3700605	Application Date	05/07/2002
Registration Date	10/27/2009	Foreign Priority Date	NONE
Word Mark	SPY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2001/05/30 First Use In Commerce: 2001/05/30 BAGS, NAMELY, BACKPACKS AND SPORTS BAGS		

U.S. Registration No.	3750166	Application Date	10/31/2006
Registration Date	02/16/2010	Foreign Priority Date	NONE

Word Mark	SPY
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/11/16 First Use In Commerce: 2006/11/16 Retail store services and on-line retail store services featuring sunglasses, sports goggles, and wearing apparel

U.S. Registration No.	3218701	Application Date	02/02/2005
Registration Date	03/13/2007	Foreign Priority Date	NONE
Word Mark	SPYOPTIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 WEARING APPAREL NAMELY T-SHIRTS, SHIRTS, SWEATSHIRTS, PANTS, SHORTS, JACKETS, HATS, VISORS, CAPS, BELTS AND SHOES		

U.S. Registration No.	3648121	Application Date	06/04/2007
Registration Date	06/30/2009	Foreign Priority Date	NONE
Word Mark	SPYOPTIC		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 SUNGLASSES AND SPORTS GOGGLES Class 018. First use: First Use: 2001/09/01 First Use In Commerce: 2001/09/01 BAGS, NAMELY, BACKPACKS AND SPORTS BAGS

Attachments	76404043#TMSN.gif (1 page)(bytes) 77033245#TMSN.jpeg (1 page)(bytes) 78558706#TMSN.jpeg (1 page)(bytes) 77197062#TMSN.jpeg (1 page)(bytes) NoticeOfOpposition.pdf (19 pages)(1368964 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William J. Brucker/
Name	William J. Brucker
Date	12/21/2012

Case: SPYNO-419M
Trademark Application

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/580,079

Spy Optic Inc.,)	Opposition No.:
)	
Opposer)	
)	
vs.)	
)	
Base Spy Craft, LLC,)	
)	
Applicant)	

NOTICE OF OPPOSITION

In the matter of the application of Base Spy Craft, LLC of Houston, Texas (hereinafter "Applicant") for registration of the trademark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN), Application Serial No. 85/580,079, published in the Official Gazette of September 4, 2012, at TM 305 Spy Optic Inc., a California corporation, with offices at 2070 Las Palmas Drive, Carlsbad, California 92011 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark shown in Serial No. 85/580,079, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is and has been for many years engaged in the extensive development, advertising, and marketing of among other things, sunglasses, sunglass products, wearing apparel, bags and sporting goods as well as retail store services. In connection therewith, Opposer has used, or filed federal applications with an intent to

use, in interstate commerce, the marks SPY, EYESPY and SPYOPTIC (hereinafter the "SPY Trademarks"), for the aforementioned goods since long prior to Applicant's filing date of Application Serial No. 85/508,112 for the mark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN).

2. Since at least as early as the dates set forth in the attached registrations, Opposer has made use of its SPY Trademarks throughout the United States in interstate commerce. Since adoption of its SPY Trademarks, Opposer has continuously used such marks in connection with the manufacture and sale of its goods and services throughout the United States in interstate commerce.

3. Opposer has expended considerable sums in exerting every effort to maintain the highest standard of quality for its products, and has created valuable goodwill among the purchasing public under its SPY Trademarks.

4. As a result of the continuous and extensive use of the SPY Trademarks by Opposer, such marks have become and continue to function as a valuable business and marketing asset of Opposer, and serves to indicate to the trade and consuming public the products and services originating from Opposer and its authorized representative.

5. Opposer has obtained United States Trademark Registration No. 1,981,513, registered June 18, 1996, for the mark SPY for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit A**.

6. Opposer has obtained United States Trademark Registration No. 1,989,431, registered July 30, 1996, for the mark EYESPY for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit B**.

7. Opposer has obtained United States Trademark Registration No. 3,700,605, registered October 27, 2009, for the mark SPY for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit C**.

8. Opposer has obtained United States Trademark Registration No. 3,750,166, registered February 16, 2010, for the mark SPY for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit D**.

9. Opposer has obtained United States Trademark Registration No. 3,218,701, registered March 13, 2007, for the mark SPYOPTIC for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit E**.

10. Opposer has obtained United States Trademark Registration No. 3,648,121, registered June 30, 2009, for the mark SPYOPTIC for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit F**.

11. Notwithstanding Opposer's rights in and to said SPY trademarks, Applicant, on information and belief, filed an application for registration of SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN) in International Classes 009, 018, 025, 028, 035 and 041 on March 26, 2012. Said application was published for opposition in the Official Gazette of September 4, 2012 at TM 305.

12. Pursuant to Trademark Rules of Practice 2.102, Opposer filed a Request to Extend Time for Filing this Notice of Opposition to January 2, 2013. A copy of said Request to Extend Time is attached hereto as **Exhibit G**.

13. The mark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN) set forth in the subject application for the goods and services listed therein is confusingly similar to Opposer's SPY trademarks, and its registration and use by

Applicant on the goods claimed in the subject application is likely to cause confusion, deception and mistake.

14. Applicant's use of the mark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN) with respect to the objected-to classes interferes with Opposer's use of its SPY trademarks and dilutes the strength of Opposer's SPY trademarks, and use of, or registration of, the mark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN) by Applicant will seriously damage Opposer.


WHEREFORE, Opposer believes that it will be damaged by said registration and prays that the registration of the mark SPY THE SECRET WORLD OF ESPIONAGE (PLUS DESIGN) to Applicant be denied.

The filing fee for this Opposition in the amount of \$1,200 (four international classes) is enclosed. Opposer's representative authorizes the charging of any additional fees to its Deposit Account No. 19-4330.

Respectfully submitted,

STETINA BRUNDA GARRED & BRUCKER

Dated: 12/20/12

By:  _____

Kit M. Stetina, Reg. No. 29,445

William J. Brucker, Reg. No. 35,462

75 Enterprise, Suite 250

Aliso Viejo, CA 92656

(949) 855-1246

Counsel for Opposer

Spy Optic Inc.

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 1,981,513

United States Patent and Trademark Office

Registered June 18, 1996

**TRADEMARK
PRINCIPAL REGISTER**

SPY

NO FEAR, INC. (CALIFORNIA CORPORATION)
2251 FARADAY AVE.
CARLSBAD, CA 92008

FIRST USE 9-0-1994; IN COMMERCE
1-0-1995.

SN 74-515,876, FILED 4-7-1994.

FOR: GLASSES AND SUNGLASSES, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

IRENE D. WILLIAMS, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 9

Prior U.S. Cls.: 2 and 26

United States Patent and Trademark Office

Reg. No. 1,989,431

Registered July 30, 1996

**TRADEMARK
PRINCIPAL REGISTER**

EYESPY

SPY OPTICS, INC. (CALIFORNIA CORPORATION)
2251 FARADAY AVENUE
CARLSBAD, CA 92008 , ASSIGNEE OF MIZ-
RAHI, ELLIOT (UNITED STATES CITIZEN)
WEST LONG BRANCH, NJ 07764

FOR: EYEGLASSES, SUNGLASSES, EYE-
GLASS CORDS AND EYEGLASS CASES, IN
CLASS 9 (U.S. CLS. 2 AND 26).

FIRST USE 1-0-1985; IN COMMERCE
1-0-1985.

SER. NO. 74-512,106, FILED 4-7-1994.

IRENE D. WILLIAMS, EXAMINING ATTOR-
NEY

EXHIBIT C

United States of America

United States Patent and Trademark Office

SPY

Reg. No. 3,700,605 SPY OPTIC, INC. (CALIFORNIA CORPORATION)
Registered Oct. 27, 2009 1260 AVENIDA CHELSEA
VISTA, CA 92083

Int. Cl.: 18 FOR: BAGS, NAMELY, BACKPACKS AND SPORTS BAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

TRADEMARK FIRST USE 5-30-2001; IN COMMERCE 5-30-2001.
PRINCIPAL REGISTER

SER. NO. 76-404,043, FILED 5-7-2002.

HENRY S. ZAK, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

EXHIBIT D

United States of America

United States Patent and Trademark Office

SPY

Reg. No. 3,750,166 SPY OPTIC, INC. (CALIFORNIA CORPORATION)
Registered Feb. 16, 2010 2070 LAS PALMAS DRIVE
CARLSBAD, CA 92009

Int. Cl.: 35 FOR: RETAIL STORE SERVICES AND ON-LINE RETAIL STORE SERVICES FEATURING
SUNGLASSES, SPORTS GOGGLES, AND WEARING APPAREL, IN CLASS 35 (U.S. CLS.
100, 101 AND 102).

SERVICE MARK
PRINCIPAL REGISTER FIRST USE 11-16-2006; IN COMMERCE 11-16-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,981,513.

SN 77-033,245, FILED 10-31-2006.

JILL PRATER, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office

EXHIBIT E

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 3,218,701

United States Patent and Trademark Office

Registered Mar. 13, 2007

**TRADEMARK
PRINCIPAL REGISTER**

SPYOPTIC

SPY OPTIC, INC. (CALIFORNIA CORPORATION)
2070 LAS PALMAS DRIVE
CARLSBAD, CA 92009

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: WEARING APPAREL NAMELY T-SHIRTS,
SHIRTS, SWEATSHIRTS, PANTS, SHORTS, JACK-
ETS, HATS, VISORS, CAPS, BELTS AND SHOES, IN
CLASS 25 (U.S. CLS. 22 AND 39).

SN 78-558,706, FILED 2-2-2005.

FIRST USE 7-0-2004; IN COMMERCE 7-0-2004.

JULIE WATSON, EXAMINING ATTORNEY

EXHIBIT F

Int. Cls.: 9 and 18

Prior U.S. Cls.: 1, 2, 3, 21, 22, 23, 26, 36, 38, and 41

United States Patent and Trademark Office

Reg. No. 3,648,121

Registered June 30, 2009

**TRADEMARK
PRINCIPAL REGISTER**

SPYOPTIC

SPY OPTIC, INC. (CALIFORNIA CORPORATION)
2070 LAS PALMAS DRIVE
CARLSBAD, CA 92009

FOR: SUNGLASSES AND SPORTS GOGGLES, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 9-1-2002; IN COMMERCE 9-1-2002.

FOR: BAGS, NAMELY, BACKPACKS AND
SPORTS BAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22
AND 41).

FIRST USE 9-1-2001; IN COMMERCE 9-1-2001.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,981,513.

SN 77-197,062, FILED 6-4-2007.

RON FAIRBANKS, EXAMINING ATTORNEY

EXHIBIT G

ESTTA Tracking number: **ESTTA493434**

Filing date: **09/10/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: **BASE SPY CRAFT, LLC**
Application Serial Number: **85580079**
Application Filing Date: **03/26/2012**
Mark: **SPY THE SECRET WORLD OF ESPIONAGE**
Date of Publication: **09/04/2012**

First 90 Day Request for Extension of Time to Oppose for Good Cause

Pursuant to 37 C.F.R. Section 2.102, Spy Optic Inc., 2070 Las Palmas Drive, Carlsbad, CA 92009, UNITED STATES, a corporation organized under the laws of California, respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown.

Potential opposer believes that good cause is established for this request by:

- The potential opposer needs additional time to investigate the claim

The time within which to file a notice of opposition is set to expire on 10/04/2012. Spy Optic Inc. respectfully requests that the time period within which to file an opposition be extended until 01/02/2013.

Respectfully submitted,

/kms/

09/10/2012

Kit M. Stetina

Stetina Brunda Garred & Brucker

75 Enterprise Ste 250

Aliso Viejo, CA 92656

UNITED STATES

opposition@stetinalaw.com

949-855-1246

PROOF OF SERVICE


State of California)
) ss.
County of Orange)

I am over the age of 18 and not a party to the within action; my business address is 75 Enterprise, Suite 250, Aliso Viejo, California 92656. On **December 20, 2012**, the attached **NOTICE OF OPPOSITION** was served on all interested parties in this action by U.S. Mail, postage prepaid, at the address as follows:

Base Spy Craft, LLC
1800 Post Oak Blvd.
6 Blvd. Place, Suite 450
Houston, Texas 77056

John B. Swingle
Williams Mullen
222 Central Park Ave., Suite 1700
Virginia Beach, Virginia 23462

Executed on **December 20, 2012** at Aliso Viejo, California. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of STETINA BRUNDA GARRED & BRUCKER at whose direction service was made.


Tara Hamilton